(13)

No. 95-728

IN THE SUPREME COURT
OF THE UNITED STATES, OCTOBER TERM, 1995

WARNER-JENKINSON COMPANY, INC.,
Petitioner,

v.

HILTON DAVIS CHEMICAL CO.,
Respondent.

On Writ of Certiorari to the United States
Court of Appeals for the Federal Circuit

BRIEF OF AMICUS CURIAE MICRON SEPARATIONS, INC. IN SUPPORT OF PETITIONER

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STATEMENT OF INTEREST

Micron Separations, Inc. ("MSI") files this *amicus curiae* brief in support of petitioner Warner-Jenkinson's petition seeking reversal of the Federal Circuit's decision in this case, and in support of Warner-Jenkinson's request that reasonable limits be placed on the doctrine of equivalents. MSI has obtained consent from both petitioner Warner-Jenkinson and respondent Hilton Davis to file this *amicus* brief, and files those consents with this brief.

MSI has a particular interest in this proceeding. It is a Massachusetts-based high technology company that develops nylon membrane filtration products for the biotechnology industry. MSI developed a product specifically to avoid

express claim limitations in a patent owned by Pall Corporation, and now has been in a ten-year patent battle with Pall over this patent's scope. MSI currently has pending a petition for certiorari, *Micron Separations, Inc. v. Pall Corp.*, No. 95-1096, filed December 26, 1995, seeking reversal of a Federal Circuit judgment which used the *Hilton Davis* decision to allow expansion of the Pall patent beyond its literal scope. MSI's case necessarily will be impacted by this Court's decision in *Hilton Davis*.[1]

MSI submits this *amicus* brief to bring to the Court's attention an argument regarding the scope of the patent law's doctrine of equivalents which MSI believes will not otherwise be presented by the parties in their main briefs: namely, how can the Federal Circuit permit the broadening of a patent claim under the doctrine of equivalents to ignore an express claim limitation, when both the reexamination *and* reissue statutes (35 U.S.C. §§ 251, 305) prohibit the broadening of claims so long after issuance?

[1] Pall Corporation also has charged other newer MSI membrane products with infringement of the same patent under the doctrine of equivalents. *See Micron Separations, Inc. v. Pall Corp.*, D. Mass. No. 94-11377-WGY; and *Pall Corp. v. Micron Separations, Inc.*, D. Mass. No. 95-12731-WGY, which is consolidated with *Pall Corp. v. Fisher Scientific Co.*, D. Mass. No. 95-12473-WGY. Because the Federal Circuit's claim interpretation broadened the scope of the Pall claim, the Patent Office has now instituted a reexamination procedure in view of "substantial new questions" regarding the patentability of the claimed technology.

STATUTORY PROVISIONS

35 U.S.C. § 251 provides in pertinent part:

> Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.
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> * * * * * * * *
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> *No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.* (Emphasis added).

35 U.S.C. § 305 provides in pertinent part:

> In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto . . . . *No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding* under this chapter . . . (Emphasis added).

SUMMARY OF ARGUMENT

This case involves a question of fundamental importance to patent law -- how broadly may a patent claim be construed under the doctrine of equivalents when the accused device or process clearly does not fall within the literal scope of the patent claim at issue? Petitioner Warner-Jenkinson is expected to address many of the key issues impacting on this question, and to establish the need for a doctrine that allows the public to make rational predictions of what infringes a patent claim.

One issue Warner-Jenkinson may not address, and which therefore is discussed in this *amicus* brief, concerns the incongruence between the Federal Circuit's *Hilton Davis* decision permitting a fact finder to broaden a claim beyond its express limitations, and existing patent law statutes and decisions which *prohibit* broadening a claim when using a legitimate Patent Office procedure.

This *amicus* brief also is intended to demonstrate the prevalence of similar cases involving the doctrine of equivalents. As the *MSI* case (petition for certiorari pending, No. 95-1096) and *Hilton Davis* show, those who seek to manufacture and design in competitive areas need to be able to operate their businesses knowing that an express numerical range in a patent is meaningful, and that the claimed range will not be unreasonably broadened under the doctrine of equivalents.

There is a need for the Supreme Court to provide concrete, narrowly defined limits to the doctrine of equivalents, so that businesses can make reasonable decisions based on patent claims as written.

ARGUMENT

HILTON DAVIS DIRECTLY CONFLICTS WITH FEDERAL CIRCUIT AND SUPREME COURT PRECEDENT PROHIBITING THE BROADENING OF CLAIMS.

Both *Hilton Davis* and the *MSI* case involve patents on polymer membrane technology, with claims including narrow numerical ranges. In *Hilton Davis*, the patentee-respondent narrowed its claims during the patent application process to require the use of a pH range of "from approximately 6.0 to 9.0." *Hilton Davis*, 62 F.3d at 1515-16. Similarly, in the *MSI* case, the patentee-respondent narrowed its claims to require use of a nylon having a specific chemical ratio within a range of "about 5:1 to about 7:1." *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1217 (Fed. Cir. 1995).

In *Hilton Davis*, the Federal Circuit agreed that a pH of 5 does not literally infringe a claim limitation of "approximately 6.0 to 9.0," but concluded that a pH of 5 nevertheless infringes under the doctrine of equivalents. *Hilton Davis*, 62 F.3d at 1515-16. In the *MSI* case, the Federal Circuit agreed that a chemical ratio of 4:1 does not literally infringe a claim limitation of "about 5:1 to about 7:1," but concluded that a ratio of 4:1 nevertheless infringes, also under the doctrine of equivalents. *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1217 (Fed. Cir. 1995). The Federal Circuit clearly sees no problem using the doctrine of equivalents to expand the scope of a claim beyond its literal meaning -- in both *MSI* and *Hilton Davis*, the court upheld a finding of infringement even though the

accused processes and products were well below the claimed lower limit of the ranges.

Yet, while the Federal Circuit is willing to allow a fact finder to broaden claims, the Federal Circuit has been particularly strict about prohibiting the Patent Office from doing the same. Indeed, the Federal Circuit has very strictly construed statutes which *prohibit* a patent-holder from broadening claims at the Patent Office except in limited circumstances.

For example, 35 U.S.C. § 305, relating to reexamination proceedings at the Patent Office, permits a patent owner to amend claims to avoid the prior art so long as the patent owner does not "enlarg[e] the scope of a claim. . . ." 35 U.S.C. § 305.[2] The statute relating to reissue proceedings, 35 U.S.C. § 251, also allows amendment of claims, but requires that "[n]o reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent."[3]

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[2] During reexamination, the Patent Office considers whether a prior art technical reference has any bearing on the patentability of claims in an issued patent. 35 U.S.C. §§ 304-305.

[3] During reissue proceedings, a patentee is allowed to correct errors in the patent as originally issued. 35 U.S.C. §§ 251-252. The reissue statutes provide only a limited two year period in which a patentee may correct a claiming mistake by seeking claims broader than those in the original patent. They also limit the potential recovery based on such broadened claims to the period after the claims were broadened, to avoid ensnaring one who began competing before the broadened claim was issued and became known to the public.

In interpreting the reexamination statute in *Quantum Corp. v. Rodime, PLC*, the Federal Circuit invalidated a patent claim which was "broadened" when the patentee merely added the word "approximately" during a reexamination proceeding to make a claim read "at least *approximately* 600" tracks per inch. *Quantum Corp. v. Rodime, PLC*, 65 F.3d 1577, 1579, 1584 (Fed. Cir. 1995), *petition for cert. filed*, Feb. 26, 1996.[4] In addressing the reissue statute in *Seattle Box Co. v. Industrial Crating & Packing*, the Federal Circuit held that adding the phrase "substantially equal to" during a reissue proceeding to make a claim read "*substantially equal to* or greater than" a pipe diameter improperly *broadened* the claim, and therefore prohibited the patent owner from recovering damages for the defendant's activities before the reissue patent was granted. *Seattle Box*, 731 F.2d 818, 822, 828 (Fed. Cir. 1984).

The limitations on broadening found in 35 U.S.C. §§ 251 and 305 trace back to long-standing Supreme Court precedent, under which the broadening of patent claims after issuance was held to be the exception and not the rule. *Miller & Co. v. Bridgeport Brass Co.*, 104 U.S. (14 Otto) 350 (1882); *see Coon v. Wilson*, 113 U.S. 268 (1885). These cases confirm the reasonable policy furthered by 35 U.S.C. §§ 251 and 305, and adopted by the Federal Circuit in *Quantum* and *Seattle Box*, that to determine what products or processes can or cannot be made, used, or sold, the public is entitled to rely on patent claims as they issue. *Hilton Davis* directly clashes with that policy. *Hilton Davis* provides a patentee with an incentive to sidestep the reissue

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[4] The test for whether a patent claim is broadened, although originally applied to reissued patents, applies to reexamined patents as well. *In re Freeman*, 30 F.3d 1459, 1464 (Fed. Cir. 1994).

and reexamination statutes by allowing retroactive enforcement of a claim broadened under the doctrine of equivalents. There is no reason a patent owner should be able to skirt established Patent Office rules and restrictions to obtain from a court relief not otherwise available.

This incongruity between the Federal Circuit prohibiting the broadening of claims during reexamination or reissue proceedings at the Patent Office, but permitting the broadening of claims at trial under the doctrine of equivalents, is highlighted by the opposite outcomes likely to result had Hilton Davis sought through reexamination or reissue the same claim scope it was awarded under the doctrine of equivalents. That is, if at the time Hilton Davis filed suit, it had sought reexamination or reissue at the Patent Office, and during that proceeding it had changed the lower limit of its claim from "approximately 6.0" to "approximately 5.0," under section 305's limitations on reexamination and section 251's limitations on reissue, the court would have been obligated to *invalidate* the claim. If Hilton Davis had asked the Patent Office (rather than the court) to fix its claims, and the Patent Office had done so, Hilton Davis could not have enforced its claims against Warner-Jenkinson.

The Federal Circuit provides no explanation for its uneven treatment of patent claims. On the one hand, the Federal Circuit gives fact finders free reign to broaden and enforce patent claims well beyond their express numerical limits. Yet on the other hand, the Federal Circuit invalidates claims for "enlarging" their scope merely by adding the word "approximately" to a numerical value. The Federal Circuit's decision allowing the broadening of claims through the doctrine of equivalents essentially renders the reexamination and reissue statutes superfluous. In view of

the statutory restrictions on reexamination and reissue, patentees now are certain to avoid those congressionally-sanctioned proceedings, opting instead for the wide-open possibility that a jury or judge will broaden claims at trial using the *Hilton Davis* doctrine of equivalents.

CONCLUSION

The *Hilton Davis* conclusion that a process infringes even though it falls outside the terms of the patent claim legitimizes after-the-fact enlargement of a claim. That conclusion directly contradicts patent law statutes which prohibit enlarging claims in a reexamination or reissue years after the patent issues, and law requiring express claim language that is "conspicuous and unambiguous..." such that "the interested public is entitled to rely on it. . . ." *Modine Mfg. Co. v. United States Int'l Trade Comm'n*, 75 F.3d 1545, 1552 (Fed. Cir. 1996), *petition for cert. filed*, Mar. 25, 1996. Without the ability to rely on "conspicuous and unambiguous" written claim language, how can honest competitors determine whether to invest in making a competitive product or using a competitive process?

Under the guise of the doctrine of equivalents, the Federal Circuit now allows enlargement and enforcement of a claim well beyond its literal terms. That broad view of the doctrine of equivalents goes far beyond what the doctrine was intended to do, and stymies the public from making rational predictions of what infringes and what does not.

Accordingly, the judgment of the Court of Appeals for the Federal Circuit should be reversed, and reasonable limitations should be placed on the doctrine of equivalents, in line with statutes and long-standing policy.

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Respectfully submitted,

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